



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q78521

WATANABE, Shinji, et al.

Appln. No.: 10/798,319

Group Art Unit: 2818

Confirmation No.: 6147

Examiner: Phuc T. Dang

Filed: November 20, 2003

For: SIZE REDUCTION OF CHIP MOUNTING SYSTEM

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the November 3, 2005 *Election Requirement*, Applicants respectfully submit the following comments.

First, Applicants respectfully submit that the *Election Requirement* is invalid on its face, as the indication of a relationship between species and claims is incorrect. As explained in MPEP § 806.04(e), “[c]laims are never species,” but rather, “[s]pecies are always the specifically different embodiments.”¹ In other words, the Examiner can identify embodiments of the Application (e.g., figures) as species, but not claims.

¹ MPEP § 806.04(e) further indicates that “the scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of the claim (and thus be designated a generic or genus claim).”

Further, as explained in the September 9, 2005 *Response*, an exemplary embodiment of the invention is shown in full in FIG. 6 of the Application, and FIGS. 7-12B show this exemplary embodiment in greater detail. All of the pending claims 1 and 36-69 read on the embodiment shown in FIG. 6, which has been previously elected by Applicants in the September 9, 2005 *Response*.²

Thus, as all of the claims read on a single disclosed embodiment, Applicants respectfully submit that no *Election Requirement* is proper with respect to the claims of this Application.³

Further, Applicants respectfully submit that all of the features recited in independent claims 36 (part of the Examiner's Species I) and 53 (part of the Examiner's Species II) are also specifically recited in independent claim 66 (part of the Examiner's Species III). Thus, the Examiner's allegation that "there is no reason to believe that the searches would be identical" is incorrect, as he necessarily would have to search for the features recited in independent claims 36 and 53 should Applicants elect Species III.

In view of the above, Applicants respectfully request that the Examiner withdraw the instant Election Requirement.

Although Applicants do not agree that the *Election Requirement* is in any way correct, Applicants elect the Examiner's identified Species I (claims 1 and 36-52) to comply with USPTO practice requirements.

Applicants reserve the right to file a Divisional Application directed to non-elected claims.

² FIG. 6 is part of Species I listed in the August 9, 2005 *Office Action*.


³ See MPEP § 806.03.

Response To Election Of Species Requirement
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Timothy P. Cremen
Registration No. 50,855

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

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